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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,066	07/21/2003	Wes Johnson	1842-0018	5163

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EXAMINER

SHAFFER, RICHARD R

ART UNIT	PAPER NUMBER
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3733

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/624,066	Applicant(s) JOHNSON ET AL.	
	Examiner Richard R. Shaffer	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 117, 118, 121, 125-129 and 201-216 is/are pending in the application.
- 4a) Of the above claim(s) 205-216 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 117, 118, 121, 125-129 and 201-204 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/3/06, 3/14/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Election/Restrictions***

Newly submitted claims 205-216 are directed to an invention that is independent or distinct from the invention originally claimed for as explained in the original election/restriction requirement. Applicant alleged that because it included the same limitations as the independent apparatus claim, it should be allowed for prosecution. However, as soon to be evident, the apparatus claims are still not allowable.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 205-216 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 117, 118, 121, 125-129, and 204 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 39-71 of U.S. Patent No. 6,595,998. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences between the application and patent lies in the fact that the patent claims include many more elements and is thus more specific. Thus, the patent as claimed in 39-71 is in effect a "species" of the "generic" invention of claims 117, 118, 121, 125-129, and 204 in the current application. It has been held that the generic invention is "anticipated" by the "species." See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

It is understood that applicant intends to file a terminal disclaimer should the claims otherwise be allowable.

Claim Rejections - 35 USC § 112

The amendments to the claims received on March 7th, 2006 corrects the indefiniteness of the claims. The rejection under 35 U.S.C. 112 2nd paragraph has been withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 117, 118, 121 125-129, and 204 are rejected under 35 U.S.C. 102(b) as being anticipated by Brantigan (US Patent 5,192,327).

Brantigan discloses an apparatus (**Figure 6**) comprising a plurality of wafers (**31**); they can be disposed atop one another (**Column 5, Lines 44-47**) in cooperative contact forming a structure intended for use between two vertebral bodies; the structure is expandable (*Definition by Merriam-Webster 10th Edition: to increase the extent, number, volume, or scope of*) if one so desired to add subsequent wafers atop another allowing the device to be capable of distraction (*Definition by Merriam-Webster 10th Edition: to draw or **direct to a different object or in different directions at the same time***) of the two vertebral bodies as well; each wafer interfaces with another via surfaces that are generally flat with complementary ridges (**22b**) and grooves (**22c**) to provide for constrained degrees (against the ridges as well as supporting the wafers vertically) of contact; and the wafers are capable of being inserted into the intervertebral space by moving the insertion tool sideways instead of forward/backward.

Claims 117 and 201-203 are rejected under 35 U.S.C. 102(b) as being anticipated by Samani (US Patent 5,645,599).

Samani discloses a device (**Figure 4**) comprising a plurality of wafers (**1**) with additional wafers (**15**) configured for consecutive receipt, wherein the top wafer has a length (length of **5b**) larger than wafer (**15**), and the bottom wafer has a length (length **5b**) larger than wafer (**15**). Again, the device is expandable according the Merriam-Webster dictionary by increasing in number and is inherently capable of distraction of the intervertebral bodies when wafer (**15**) is inserted.

Response to Arguments

Applicant's arguments filed on March 7th, 2006 have been fully considered but they are not persuasive. In regard to Brantigan, another embodiment (**Figure 6**) has been used against applicant's case that a support bar is required for the inserts.

Column 5, Lines 45-47 clearly state that individual inserts have an integral bar and can be stacked like the separate bar embodiment. Further, it does not matter that Brantigan contemplates that his device is to be inserted as a single structure. It is inherently capable by design to function as claimed. It is expandable by definition, it is inherently capable of distraction (should one force them between two vertebral bodies), and they can be inserted one after another because insertion is not limited to positioning them atop each other in the direction of the bores (**13**). One could easily position the inserts atop one another by moving them sideways.

In regard to Samani, the "bearing cushion" (**15**) again is inherently capable of being inserted consecutively and then fixed by any known means known in the art.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not


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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

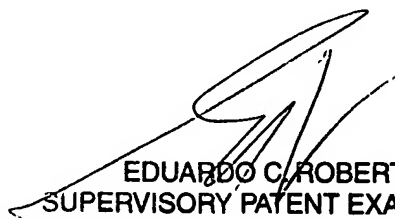
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard R. Shaffer whose telephone number is 571-272-8683. The examiner can normally be reached on Monday-Friday during (7am-5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Richard Shaffer
April 28th, 2006



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER